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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,955	03/11/2004	Timothy D. Killinger	29618/39225D	7721

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MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

NEWTON, JARED W

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/798,955

Applicant(s)

KILLINGER ET AL.

Examiner

Jared W. Newton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2006 has been entered.

Drawings

The drawings were received on November 20, 2006. These drawings are in compliance with all requirements and entered herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-10, and 12-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the

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recitations: "the file suspension device including a first rail extending rearwardly ... and a second rail extending rearwardly..." (claim 1); "wherein the openable panel is pivotable independently of the position of the top panel" (claim 17, lines 7-8); and "wherein the top panel is in a fixed, generally horizontal position" (claim 21, lines 1-2) were not described in the specification as originally filed.

The new subject matter should be canceled from the claims.

Claim Rejections - 35 USC § 102

Claims 1-8 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,505,388 to Solomon.

In regard to claims 1 and 17, Solomon discloses an expandable filing system comprising: an exterior shell 10 having an outer surface (see FIGS. 1 and 2); an openable panel 16 defining part of the exterior shell, the openable panel having a bottom edge 32, a forward facing surface, and a rear facing surface (see FIG. 2), the openable panel 16 being pivotal about the bottom edge 32 outward from the exterior shell between a retracted condition (see FIG. 2) at which the forward facing surface is generally flush with the outer surface of the exterior shell and an open condition 34 (see FIG. 2, phantom) away from the outer surface of the exterior shell; and

a file support structure (see Abstract, ln. 14-15) capable of suspending a file at any position along its length when the openable panel is in the open condition, said structure having a file storage area, an open top for insertion, access to, and removal of files from the file storage area, a pair of panels 66 extending rearward from the rear

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facing surface of the openable panel defining in part the file storage area, and a file suspension device (upper edges of panels 66—see col. 2, ln. 55-65) provided to suspend files within the file storage area, the file support structure disposed adjacent to the rear facing surface of the openable panel and being movable in concert with the openable panel (see FIG. 2), wherein the open top is accessible when the openable panel is in the open condition (see FIG. 2, phantom) and wherein the file support structure is disposed within the exterior shell when the openable panel is in the retracted condition (see FIG. 2).

In regard to claim 2, Solomon further discloses the exterior shell comprising: a pair of opposed side panels 12 and 14; and a front panel 16 defined at least in part by the openable panel (see FIG. 2).

In regard to claims 3 and 18, Solomon further discloses the file support structure comprising: a pair of suspension surfaces (upper edges of panels 66) on laterally spaced apart and opposed side of the open top (see FIG. 2).

In regard to claim 4, Solomon further discloses the pair of suspension surfaces arranged to present files suspended in the file storage area in a forwardly and downward cascading arrangement (see FIG. 2, phantom).

In regard to claims 5 and 19, Solomon further discloses each pair of suspension surfaces as arched (see FIG. 2).

In regard to claims 6 and 7, Solomon further discloses the exterior shell comprising a top panel 22 providing a generally horizontal support surface in the form of a table when the openable panel is in the retracted position (see FIG. 2).

In regard to claim 8, Solomon further discloses the exterior shell and the openable panel 16 as combinable to form a configuration that hides the file storage area of the storage device when the openable panel is in the closed condition (see FIG. 2).

In regard to claim 20, said suspension surfaces extend continuously from the openable panel to a rear end (see FIG. 2).

Claim Rejections - 35 USC § 103

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,505,388 to Solomon as applied to claims 1-8 and 17-20 above, and further in view of US Patent No. 4,666,047 to Fletcher.

Solomon discloses the expandable filing system as set forth above, including all of the limitations of claims 10-16. Solomon does not specifically set forth the file suspension supports (shown as the upper edges of panels 66) as having a series of notches. Fletcher discloses a hanger support for filing cabinets comprising: frame members 26 and 28 for supporting stationary rails 18 and 20, said rails adapted for receiving suspension rails 50 and 52 for supporting file hangers (see FIGS. 1 and 6). Fletcher further discloses each of said stationary rails comprising a plurality of notches 44 (see FIG. 1), wherein said notches retain said suspension rails, and thus said file hangers. The Solomon and Fletcher references are analogous art because they are from the same field of endeavor—file suspension devices. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the notches as disclosed by Fletcher on the upper edges of the panels as disclosed by Solomon. The

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motivation would have been that as set forth by Fletcher—to maintain files in a spaced relationship (see Fletcher, col. 4, ln. 4-15). It would be an obvious and successful improvement to the upper shoulders of the panels 66 of Solomon, to provide said shoulders with evenly spaced notches, in order to maintain files in an evenly spaced and orderly manner.

Response to Arguments

Applicant is thanked for his correction of the Drawings set forth in the Amendment filed November 20, 2006.

Applicant's arguments filed November 20 have been fully considered but they are not persuasive.

With respect to Applicant's Amendments to claims 1, 9, and 17, as noted above the claims include new subject matter that was not described in the application as originally filed. With respect to the newly added "first and second rails" of claims 1, 4, 5, 9, 12, and 13, the originally filed specification and drawings do not disclose or show rails. In his Remarks, Applicant recites, "Support for the claimed rail can be found in the specification with reference to the suspension surfaces 54. One of ordinary skill would understand that a suspension surface for a hanging file folders would include a rail." The specification is void of any reference to a "rail," as well as a rail extending "adjacent the first panel" as claimed. The suspension surfaces 54 as shown and described in the original specification serve an identical function to those as set forth by Solomon—that is, to suspend file folders. It is further noted that the L-shaped shoulder suspension

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surface set forth by Solomon could also be considered a rail (see Solomon, col. 2, lines 55-65), and thus the Solomon reference would anticipate the instant invention were there support in the original specification for the "rails".

Still further, as set forth by Applicant in his Remarks, it would be obvious to one of ordinary skill in the art at the time of the invention to include rails as part of the suspension surface in a device for supporting hanging file folders (see Remarks, pg. 9, paragraph 3). Thus, even if the present invention did include the non-described rails separate from and adjacent to the suspension surface, by Applicant's own admission, it would be obvious to include like rails on the invention disclosed by Solomon.

Nor does Solomon teach away from a pair of rails. To the contrary, Solomon teaches the same motivation as the instant invention—to support file folders in both storage and easily accessible positions. Both inventions support file folders on a pivoting openable surface having a front panel and rearward extending side panels on which the file folders rest. The fact that Solomon provides means for supporting additional folders behind the pivoting support feature certainly does not detract from his desire to store and access file folders. Applicant's assertion, "the hooks of files may catch on the front portion of the supports 40 [taught by Solomon]" is speculation, and irrelevant to the question of whether the Solomon reference teaches the claimed limitations. Applicant's assertion, "Because Solomon teaches away from the claimed construction, Solomon cannot be used as a prior art reference" is incorrect. Applicant is reminded, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

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Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

With respect to the newly added limitations, "wherein the openable panel is pivotable independently of the position of the top panel" and "wherein the top panel is in a fixed, generally horizontal position," it is respectfully asserted that neither of these limitations was set forth in the specification as originally filed. It is improper to import limitations into the claimed invention that were not expressly described, or for which no motivation was given in the original specification. It appears that the Applicant has included these limitations in an attempt to overcome the Solomon reference; however, the specification does not disclose these features, and the motivation for their inclusion into the claims set forth in the Remarks cannot be inferred from the specification.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

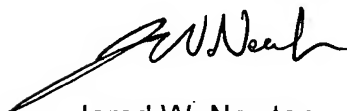
- US Patent No. 2,201, 547 to Sol Scheinman
- US Patent No. 2,967,079 to Pietro Parvis
- US Patent No. 4,325,595 to Solomon
- US Patent No. 4,936,454 to Wang
- US Patent No. 5,800,027 to Dunn

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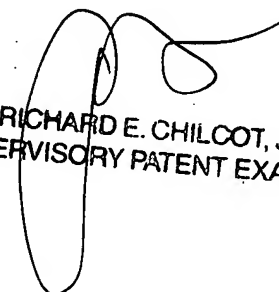
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jared W. Newton
February 8, 2007
JWN



RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER